

Docket No.: 113708.123

PATENT/OFFICIAL



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Applicant: Eugene M. LEE

Serial No.: 09/460,806

Filed: December 14, 1999

For: FEE TRANSACTION SYSTEM AND  
METHOD FOR INTELLECTUAL PROPERTY  
ACQUISITION AND/OR MAINTENANCE

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

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: Examiner: Jonathan P. Ouellette  
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: Art Unit: 3629  
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#14/appeal  
Brief  
+ fee  
2-14-04

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FEB 10 2004

GROUP 3600

SUBMISSION OF APPELLANT'S BRIEF UNDER 37 C.F.R. § 1.192

Appellant submits herewith, in triplicate, Appellant's Brief under 37 C.F.R. § 1.192.

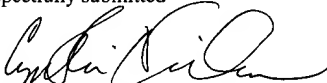
The Appellant's Brief is being submitted after the filing of the Notice of Appeal, i.e.,  
July 25, 2003. Applicant petitions the Commissioner of Patents and Trademarks to extend the  
time for submitting the brief for four months (Notice of Appeal filed July 25, 2003, and the four  
month extended period from October 25, 2003 until January 25, 2004).

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Please charge the \$740.00 fee (small entity - 1/2 of \$1,480.00) to cover the cost of the extension to Deposit Account No. 08-0219. Any deficiency or overpayment should be charged or credited to Deposit Account No. 08-0219.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'Cynthia K. Nicholson', written over the printed name.

Cynthia K. Nicholson  
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Date: January 26, 2004

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**GROUP 3600**

Sir:

**APPEAL BRIEF UNDER 37 C.F.R. § 1.192**

This is an Appeal Brief from the final rejection of the Final Office Action mailed January 30, 2003, having a three-month shortened statutory period of response set to expire April 30, 2003, extended to July 25, 2003, and Notice of Appeal filed on July 25, 2003. This Brief is being filed in triplicate.

**REAL PARTY IN INTEREST**

This application is assigned to Knowledge Management Objects, L.L.C.

**RELATED APPEALS AND INTERFERENCES**

A Notice of Appeal was filed in co-pending related application Ser. No. 09/409,524 on July 22, 2003. There are no other Appeals or Interferences that may directly affect or be directly affected by or have a bearing on the Board's decision in the instant Appeal.

**STATUS OF THE CLAIMS**

This patent application was initially filed on December 14, 1999, with the U.S. Patent and Trademark Office. As filed, the application included 24 claims.

In a first Office Action dated June 26, 2002, claims 1-24 were rejected for double patenting or obviousness. Prior art rejections were based on Hunter et al., U.S. Patent 6,298,327 ("*Hunter*") alone or in combination with Bezos et al., U.S. Patent 6,029,141 ("*Bezos*") and Ferguson et al., U.S. Patent 5,819,092 ("*Ferguson*").

Appellant responded to the first Office Action with an Amendment filed on December 23, 2002, addressing the rejection, amending the claims and attempting to place the application in a condition of allowance.

A Final Office Action was issued rejecting claims 1-24 issued on January 30, 2003. The prior art rejections were based on new references Brown, Pinnisi & Michaels, PC (Internet Archive Wayback Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) ("*BPM*") in view of InventNet ([www.inventnet.com](http://www.inventnet.com), screen print 11/11/1998) ("*InventNET*"). InventNet and WIPO are cited and described in detail in the Background Art section of the present application under appeal. However, it appears that claims 22 and 23 remain rejected further over Ferguson and Hunter. A corrected reference citation Form 892, references, and Office Action were transmitted on June 11, 2003.

A reply was filed on July 25, 2003, addressing the rejections in the Final Office Action.

This Appeal follows.

The status of the pending claims is as follows:

Allowed claims: none; and

Claims rejected and on appeal: 1-24.

### **STATUS OF AMENDMENTS**

No amendment of the claims was filed subsequent to the final rejection. A copy of the claims, as they now stand, is provided in the attached Appendix.

### **SUMMARY OF THE INVENTION**

Appellant's invention is directed to solving the problem of seeking protection for intellectual property assets, potentially in multiple jurisdictions. One "need is for facilities that allow fee transactions to be exactly quoted and executed in accordance with the particulars of an intellectual property filing and in accordance with fee structures of jurisdictions and foreign associates" (Specification p. 3). In general, embodiments of the invention relate to a facility whereby an applicant (or his representative) may transact an intellectual property service, such as the preparation and filing of target-jurisdiction and associate-specific papers, in jurisdictions using multiple associates while automating the transacting of fees. Referring for example to Figure 1, an intellectual property filing portal or hub (110) communicates with both originating filers (e.g., 121, 122, 123) and associates (e.g., 131, 132, 133, 134). Target jurisdictions include, e.g., EPO, JPO and RO/US (141, 153, 142). According to an aspect of the invention, as illustrated in Figure 2, the originating filer initiates a session (201) by requesting target jurisdiction and associate information from the portal (210). The user selects (204) a set of target jurisdictions and corresponding associates for filing of, e.g., a particular intellectual property application. In response to the selection (204), the portal (210) provides the user (221) with target- and associate-specific requirements, e.g., fee schedules, form documents and formal

requirements for the particular associate and jurisdiction combination. The portal (210) receives the user's authorization (including fee authorization) (207) and filing documents. The portal (210) forwards such to the selected associates (Specification page 14, line 18 – page 16, line 22.)

Reference is now made to Figure 3, illustrating an example of filer-side data and flow control. According to one or more embodiments of the present invention, operating the intellectual property filing portal includes selecting target jurisdictions. For each target jurisdiction, an associate is selected from supported associates. Fees are requested from the intellectual property filing portal 310 for the selected target/associate combination. If the quoted fees are approved via the filing portal, the transaction is authorized and jurisdiction and associate-specific forms are prepared. (Specification page 17, line 23 – page 18, line 7).

### **ISSUES**

**Issue 1:** Are claims 1–24 unpatentable under 35 U.S.C. §103 as being obvious over a combination of Brown, Pinnisi & Michaels, PC ([www.lightlink.com/bbm](http://www.lightlink.com/bbm), Screen Print 1/18/1999) (“BPM”), in view of InventNet (Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), Screen Print 12/3/1998 – 2/9/1999) (“InventNet”)?

**Issue 2:** Are claims 22-23 unpatentable under 35 U.S.C. §103 as being obvious over a combination of Brown, Pinnisi & Michaels, PC ([www.lightlink.com/bbm](http://www.lightlink.com/bbm), Screen Print 1/18/1999) (“BPM”), in view of InventNet (Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), Screen Print 12/3/1998 – 2/9/1999) (“InventNet”), further in view of U.S. Patent No. 5,819,092 (“Ferguson”) and U.S. Patent No. 6,298,327 (“Hunter”)?

### **GROUPING OF CLAIMS**

For the purpose of this appeal, claim 14 is grouped with claim 11; claim 15 is grouped with claim 20; and claim 23 is grouped with claim 21.

The remaining claims do not stand or fall together. Instead, each of the remaining claims are believed to each have separate basis of patentability and are separately argued below.

### **ARGUMENT**

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of Brown, Pinnisi & Michaels, PC ([www.lightlink.com/bbm](http://www.lightlink.com/bbm), Screen Print 1/18/1999) ("BPM"), in view of InventNet (Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), Screen Print 12/3/1998 – 2/9/1999) ("InventNet")<sup>1</sup>. For the reasons including, *inter alia*, those discussed below, each of independent claims 1, 8, 11, 15, 21 and 24 is patentable over the applied references. Claims dependent therefrom are similarly patentable. Claims 22 and 23 further stand rejected over U.S. Patent No. 5,819,092 (Ferguson) and U.S. Patent No. 6,298,327 (Hunter) in combination with BPM and Inventnet. The rejections cannot withstand scrutiny and should be reversed for the reasons given below.

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<sup>1</sup> Certain references were incorrectly cited in the Form 892 and/or an incorrect copy of such references was provided, in connection with the final Office Action. Pursuant to applicant's request, the Examiner supplied a form 892, in which references U and V (page 1) were corrected and reference U (page 2) was added. Further correction of the following matters was requested in Appellant's reply filed July 25, 2003:

*Inventnet.com* (Reference U2) is cited without a print date or publication date. This document includes what appears to be a print date of "1/22/03." Certain pages of the references mention copyright dates of 2002. Inventnet.com (Reference U2) requires correction to reflect a print date or publication date. *PCT-Easy, User Reference Manual, PCT-EASY V 2.80, World Intellectual Property Organization* ([www.wipo.int/](http://www.wipo.int/)) (Reference W1) apparently encompasses two separate documents: a manual and a web page.

Appellant is still awaiting a response to the request for letter of correction of July 25, 2003.

## **BACKGROUND**

### **Background: BPM and Inventnet**

BPM concerns a collection of web pages, apparently produced by a US intellectual property firm, with some information about intellectual property. The portions provided by the Examiner include, *inter alia*, a page titled "Invention Disclosure Form," a page titled "Patent Information"; a page titled "Budget Estimator for Patents," and portion of a page titled "IP Resources on the Internet." The Office Action admits that BPM fails to disclose one or more target jurisdictions.

Inventnet states that it is an Internet based inventor's network. InventNet is a web site with sections titled, e.g., "Patenting Help", "Inventions for Sale," "Patent Attorneys," "About InventNET," "Patent Forms," "Patent Search," "News," "Hot Links," "Prototype Work," "Product Services," and "InventNET Inventors." The Patenting Forms Section has links to USPTO forms on the USPTO web site. Inventnet includes a Patent Attorney Directory, a listing of certain patent attorneys by zip code.

### **Background: Ferguson and Hunter**

Ferguson concerns an online service development tool with fee setting capabilities. It is addressed to creating a commercial online service with the ability to define fee structures for accessing parts of the online system and/or ordering other goods or services that usually requires specialized programming (e.g., Col. 3, lines 56-61). Hunter discloses a computer-implemented expert support system for authoring invention disclosures and evaluating patentability/marketability of an invention. (Abstract.)



**ISSUE 1:**

**Are claims 1-24 unpatentable under 35 U.S.C. §103 as being obvious over a combination of Brown, Pinnisi & Michaels, PC (www.lightlink.com/bbm, Screen Print 1/18/1999) (“BPM”), in view of InventNet (Internet Archive WayBack Machine, www.inventnet.com, Screen Print 12/3/1998 – 2/9/1999) (“InventNet”)?**

**A. There is no Prima Facie case of obviousness because the references fail to teach or suggest all claim limitations.**

To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There must also be a reasonable expectation of success. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Where, as here, the Examiner fails to establish a *prima facie* case of obviousness, Appellant has no burden to rebut the rejection of obviousness with evidence. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce

a *prima facie* case of unpatentability, then without more Appellant is entitled to grant of patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

With regard to all independent claims, the Final Office Action contends that BPM's online law firm marketing materials suggest or teach providing, in response to docket data, information representative of the intellectual property matters and the fee payments associated therewith; further that BPM teaches or suggests, that the user can select one or more of the matters and payments; and that BPM teaches or suggests, in response to the selection, initiating performance of the fee payments and substantially coincident therewith initiating payment transactions corresponding to the fee payments. (Final Office Action ¶ 5).

To the contrary, BPM fails to teach or suggest claim limitations in several claims. Appellant provides herein non-exhaustive examples of BPM's inadequacies.

BPM does not teach or suggest, for example "registering for each of plural associates ... form documents," or that the documents so registered are "corresponding to target jurisdiction and associate specifications," or "distributing at least a portion of the form documents ... for use in preparation of intellectual property documents suitable for filing" (independent claim 1). Moreover, an intellectual property matter and associated fee payment is not selectable in BPM. Hence, BPM does not do anything responsive to such selection.

The Final Office Action admits that BPM "fails to distinctly disclose one or more target jurisdictions." As merely one particular example of BPM's failings, BPM further fails to disclose "initiating performance of the selected one or more intellectual property services." (The Office Action does not contend that InventNet teaches this claimed element.)

Recognizing that BPM fails to teach and/or suggest the invention as claimed, InventNet is cited to remedy the deficiencies. For reasons including, for example, that BPM neither teaches

nor suggests such initiating performance of services or transacting fees, InventNet fails to remedy such deficiencies.

The final rejection of independent claim 1 is made together with the rejection of Claims 8, 11, 15, 21 and 24. The Office Action failed to specify the reasons for rejection particular to each independent claim, and failed to cite any particular portion of any reference support the rejection. Paragraphs 5-8 of the final Office Action appear to be directed to the limitations of claim 8. Nevertheless, the final rejection of claim 1 (and all other independent claims) is made in common with the rejection of claim 8, despite these claims reciting different limitations. Consequently, the final Office Action fails to consider whether Inventnet or BPM teach or suggest the specific limitations of claim 1 and fails to specify any particular portion of a reference to support the rejection. For this additional reason, the final Office Action fails to present a prima facie case of obviousness with respect to the limitations of claim 1 (and all other independent claims 8, 11, 15, 21, and 24).

With respect to claim 1, Inventnet and/or BPM fail to teach or suggest, for example, “initiating performance of the selected one or more intellectual property services, and ... transacting the associated one or more fees” (claim 1). Furthermore, the Office Action fails to identify whether Inventnet and/or BPM teach or suggest this claim limitation.

Claims 1-7 depend from independent claim 1, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 2, Inventnet and/or BPM fail to teach or suggest, for example, details of the intellectual property services that may be selected.

In connection with dependent claim 3, Inventnet and/or BPM fail to teach or suggest, for example, details of the transacting of the associated fees as recited.

With regard to dependent claim 4, Inventnet and/or BPM fail to teach or suggest, for example, presenting a user with “one or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions,” where the fees associated with a particular intellectual property service are “particularized by target jurisdiction and/or said one or more respective associates.”

Now considering dependent claim 5, Inventnet and/or BPM fail to teach or suggest, for example, that the information provided about the intellectual property services is “automatically” initiated, and is “in response to a docket event for a particular intellectual property matter corresponding thereto.” Neither Inventnet nor BPM teaches or suggests docket events for particular matters, and hence neither teaches or suggests automatically initiating the providing of such information.

With respect to dependent claim 6, neither Inventnet nor BPM teaches or suggests, for example, “retrieving information” characterizing an intellectual property application corresponding to a particular service, and “calculating the associated one or more fees” based on the retrieved intellectual property application information.

In connection with dependent claim 7, neither Inventnet nor BPM teaches or suggests, for example, supplying the information encoding the selected service(s) and the associated fee(s) “for use in an accounting system.” Neither Inventnet nor BPM teaches or suggests a particular fee associated with a service, and hence certainly fail to teach or suggest that such a fee is sufficiently specific as to be used in an accounting system.

Considering independent claim 8, BPM and Inventnet fail to teach or suggest, for example, “in response to selection by a user of one or more of the intellectual property matters and associated one or more fee payments, initiating performance of the one or more fee

payments, and ... initiating a payment transaction corresponding to the selected one or more fee payments between the user and an intellectual property annuity, maintenance or renewal fee payment service” (claim 8).

Claims 9-10 depend from independent claim 8, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 9, Inventnet and/or BPM fail to teach or suggest, for example, that the information which is provided representative of the intellectual property matters and associate fee payments, and the initiating of the selected fee payments, is “performed by the intellectual property annuity, maintenance or renewal fee payment service.”

Further, with regard to dependent claim 10, Inventnet and/or BPM fail to suggest, for example, that the information which is provided representative of the intellectual property matters and the fee payments “is performed by an intermediary separate from the intellectual property annuity, maintenance or renewal fee payment service.”

The rejection of independent claim 11 was made in common with claim 1 without regard to the particular limitations recited in claim 11. For the reasons given in connection with claim 1, the final Office Action therefore fails to present a prima facie case of obviousness with respect to claim 11.

Further with regard to claim 11, Inventnet and/or BPM, alone or in combination, neither teach nor suggest, for example, “registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of fees for one or more intellectual property services performed by the associate therein” (claim 11).

Claims 12-14 depend from independent claim 11, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 12, Inventnet and/or BPM fail to teach or suggest, for example, that the information distributed regarding the target jurisdiction, associates,

and corresponding fee, is in response to a user selection of target jurisdiction(s) and “for each selected target jurisdiction, a respective one or ones of the associates.”

Further, with regard to dependent claim 13, Inventnet and/or BPM fail to teach and/or suggest, for example, that the information is distributed by supplying “on a periodic basis”, the computer readable encoding of fees.

The rejection of independent claim 15 was made in common with claim 1 without regard to the particular limitations recited in claim 15. For the reasons given in connection with claim 1, the final Office Action therefore fails to present a prima facie case of obviousness with respect to claim 15.

Further with regard to claim 15, Inventnet and/or BPM, alone or in combination, neither teach nor suggest, for example, “supplying the originating node with information representative of one or more fees corresponding to the selected at least one intellectual property services, ... transacting the one or more fees substantially coincident with the initiation thereof” (claim 15).

Claims 16-20 depend from independent claim 15, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 16, Inventnet and/or BPM fail to teach or suggest, for example, anything about fees for a “particular selected target jurisdiction and associate combination.” Further, Inventnet and/or BPM fail to teach and/or suggest that the fees include the official fees for the filing in the particular jurisdiction, and the service fees of the selected associate for performing the selected service.

In addition, in connection with dependent claim 17, neither Inventnet nor BPM teaches or suggests, for example, that the target nodes coupled to the network include “computers of respective associates configured to electronically receive at least partial instructions concerning

an intellectual property filing” from the originating node, via the intellectual property service portal.

Considering now claim 18, Inventnet and BPM fail to teach or suggest, for example, a web browser included in the originating node, a web server in the portal, and that the selection of the service, the supplying of the fee information, and the transacting of the fees, is achieved by internet protocol traffic between the web browser and the web server.

With respect to claim 19, neither Inventnet nor BPM teaches or suggests, for example, the registration by associates of information representative of “fees corresponding to the associate”, and that the information that is supplied regarding fees, includes fees registered by the selected associates.

The rejection of independent claim 21 was made in common with claim 1 without regard to the particular limitations recited in claim 21. For the reasons given in connection with claim 1, the final Office Action therefore fails to present a prima facie case of obviousness with respect to claim 21.

Further with regard to claim 21, Inventnet and/or BPM, alone or in combination, fail to teach or suggest, for example, a computer program with code “to select from amongst one or more intellectual property services. . . and to initiate performance. . .”. Further, neither reference teaches or suggests code “to transact one or more fees”.

Claims 22-23 depend from independent claim 21, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 22, Inventnet and/or BPM fail to teach or suggest, for example, that the selection code (to select amongst services and to initiate performance of the services) and the fee transaction code (to transact the fees for the selected services) are “all executable on a same processor.”

The rejection of independent claim 24 was made in common with claim 1 without regard to the particular limitations recited in claim 24. For the reasons given in connection with claim 1, the final Office Action therefore fails to present a prima facie case of obviousness with respect to claim 24.

Further with regard to claim 24, neither BPM nor Inventnet teach or suggest, alone or in combination, a system with means for selecting one or more intellectual property services, means for initiating performance of the selected service(s), and/or means for transacting fees substantially coincident with the performance of the selected service(s).

Hence, BPM and Inventnet, alone or in combination, fail to teach or suggest the combination of features recited in the claims.

Furthermore, BPM and/or Inventnet operate in a fundamentally different way than the claimed invention. The combination as proposed by the Examiner would be, at most, a directory of law firms and their marketing materials in multiple jurisdictions. The Office Action cites the multiple target jurisdictions in Inventnet as disclosing one or more target jurisdictions, however, BPM and Inventnet, alone or in combination, clearly deficient considering the invention as a whole. Consequently, the proposed combination fails to teach or suggest the claimed invention.

**B. There is no Prima Facie case of obviousness where there is no motivation to combine the references.**

In addition, there is no suggestion or motivation to combine the references. "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, 977 F.2d 1443, 24 USPQ.2d 1443 (Fed. Cir. 1992). Moreover, to establish a prima facie case of obviousness, "it is



necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention.”

In re Levengood, 28 USPQ.2d 1300, 1301 (Bd. Pat. App. 1993).

Failure to point to specific information that teaches or suggests the combination claimed cannot support a conclusion of obviousness. In re Dembiczak, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). “Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ.2d 1313, 1317 (Fed. Cir. 2000). See also, Crown Operations Int’l Ltd. v. Solutia Inc., 289 F.3d 1367, 1376, 62 USPQ.2d 1917 (Fed Cir. 2002) (“there must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, ... to look to particular elements, and to combine them as combined by the inventor”).

The Office Action provides no motivation to combine the references, other than a broad, conclusory statement in paragraph 8 of the Final Office Action that the combination of “one or more target jurisdictions as disclosed by Inventnet in the system disclosed by BPM” would be made “for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities in a multitude of jurisdictions (US and foreign).” One cannot glean from Inventnet a motivation either to begin transacting intellectual property services, or to combine its patent attorney directory or other materials with, e.g., BPM’s on-line law firm marketing materials. Nor can one glean from BPM’s law firm marketing materials a motivation to include a directory of other attorneys.

In determining whether a suggestion can be fairly gleaned from the prior art, one must consider the full field of the invention, “including that which might lead away from the claimed invention.” In re Dow Chemical, 837 F.2d 469, 473, 5 USPQ.2d 1529, 1531 (Fed. Cir. 1988). It would be unusual for law firm marketing materials, such as BPM, to include a directory of other competitive attorneys. Inventnet instructs its users themselves to use a patent attorney to prepare the necessary documents (“Patenting Help” page screen). Hence it appears that the references implicitly and explicitly lead away from the invention as claimed.

Moreover, assuming *arguendo* that it may have been possible to access both over the Internet, that in itself provides no motivation to combine the references as proposed by the Examiner. To the contrary, where the prior art does not suggest the combination or convey a reasonable expectation of success of making it, there is no prima facie case of obviousness. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991).

The claimed subject matter “as a whole” must be considered in determining obviousness. E.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 449, 230 USPQ 416, 420 (Fed. Cir. 1986). Here, because there is no motivation for the combination of Inventnet and WIPO, and even the proposed combination fails to teach at least one feature taken in combination with the remainder of features of the claimed invention, the Examiner has failed to establish obviousness generally, as well as the requisite *prima facie* case. Accordingly, Appellant is not presenting, at this time, objective evidence tending to support a conclusion of non-obvious, since no such evidence is necessary at this time.

**C. The Proposed Combination fails to teach or suggest the invention as a whole.**

Assuming *arguendo* the suggested motivation, the proposed combination of references still fails to teach or suggest the invention as claimed. For example, the combination of BPM and Inventnet still fail to provide a method of transacting intellectual property transactions in multiple jurisdictions.

The claimed subject matter “as a whole” must be considered in determining obviousness. E.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., *supra*. Here, the proposed combination fails to teach at least one feature taken in combination with the remainder of features of the claimed invention.

Assuming *arguendo* a motivation to combine the two references, the proposed modification would appear to change the principle of operation of either BPM or Inventnet, or both. Inventnet claims to be an Internet based inventor’s network. The Office Action argues that Inventnet “teach the registration and selection of one or more target jurisdictions” (Final Office Action ¶7). Assuming *arguendo*, without admitting, that InventNet provides the teaching as contended in the Office Action, it is not clear how the registration or selection of one or more target jurisdictions would further teach or suggest the registration and/or selection of one or more intellectual property services (claims 1, 15, 21, 24), or selection of intellectual property matters (claim 8), or selection of jurisdiction and fees for intellectual property services (claim 11).

Hence, the proposed combination would appear to be antithetical to the fundamental principles of BPM, in order for BPM to accommodate Inventnet in the manner proposed by the Examiner.

Moreover, it appears that the Examiner is impermissibly relying on hindsight, including Applicant’s own disclosure and references available only after the filing data of the present

application. “[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teaching of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992).

The fact that an invention in hindsight may be simple, does not mean the invention is not patentable. As stated by the Federal Circuit:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting claims 1, 2, and 4-9 under 35 U.S.C. § 103(a) over Evans. Moreover, because the rejections of claims 3 and 10 rely upon the foregoing, we also conclude that the Board did not make out a proper prima facie case of obviousness in rejecting those claims under 35 U.S.C. § 103(a).

***In re Kotzab***, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000).

For at least these reasons, the combination of features recited in independent claims 1, 8, 11, 15, 21 and 24, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

With respect to the rejected dependent claims, Applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 8, 11, 15, 21 or 24, but also because of additional features they recite. Examples of some of these features were discussed previously.

For all the reasons advanced above, Applicant respectfully submits that the rejection of claims 1-24, insofar as it may be applied to the claims as amended, must be reversed.

**D. The References Teach Away From the Claimed Invention.**

A prior art reference must be considered in its entirety, including portions that would have lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied* 469 US 851 (1984). Where the reference teaches away from the claimed invention, it is a significant factor and must be weighed in substance. Further, known disadvantages in old devices would naturally discourage a search for new inventions, and must be taken into consideration in determining obviousness. United States v. Adams, 383 US 39, 52, 148 USPQ 479, 484 (1966).

BPM discloses that providing estimated fees and costs is not really possible. Specifically, BPM states:

Many of our clients have asked for a way of estimating what costs and time periods to expect when pursuing a patent on their inventions. This estimator should serve as a guide, and *is as good an estimate as we can prepare, but you should realize that the fees you will actually pay may vary widely* from these, depending on the individual circumstances of your invention.

...

BPM states the following about Foreign Filing:

In general: *It is not really possible to accurately estimate the total cost of foreign filing in a generalized way, since it varies so widely depending on what countries are chosen, what method of filing is pursued, the fees of foreign patent attorneys in each country, exchange rates, translations, etc. ... We can try to give you an estimate for your specific situation based on your fact pattern, once you have a US application on file.*

BPM teaches that fees cannot be provided in advance. BPM states “It is not really possible to accurately estimate....” “We can try to give you an estimate for your specific situation ...” (Emphasis added.) Consequently, the fees are not transacted, as claimed, when the claims are interpreted as a whole.

BPM is a reference teaching away from the claimed invention, and is highly relevant and is a significant factor to be considered in determining obviousness. The known and acknowledged difficulty of providing estimates is highly relevant. It appears that these known difficulties or impossibilities would naturally discourage a search for a new invention both providing specific fees and transacting the specific fees, as claimed.

Hence, the disclosure of BPM would have lead a person of ordinary skill in the art away from the use of fees and costs which are sufficiently definite that they can be transacted.

**E. There is no Prima Facie Case of Obviousness Where, as Here, the Rejection Relies on Impermissible Hindsight.**

The content of the prior art is determined at the time the invention was made, to avoid impermissible hindsight. “It is difficult but necessary that the decision maker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the

invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.” W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied* 469 US 851 (1984).

The accepted wisdom at the relevant time, as disclosed by BPM, is that providing accurate fees and costs, is difficult or impossible. An indication that the Examiner impermissibly relied on hindsight, is that the reference originally relied upon by the Examiner included or incorporated matter dated *after* the application filing date. The original Inventnet reference (prior to correction on June 11, 2003) included the following matter dated after the application filing date:

- (a) page 1, listing “waybackmachine” and “Search Results for Jan 01, 1996 – Jan 27, 2003” has a print date (lower right hand corner) of “1/27/03”;
- (b) page 11 has a print date of “1/27/03”; and
- (c) pages 12-16 have a print date of “1/22/03”, and elements titled “New Patent Fees starting October 2001”, “Images from Yankee Invention Exhibition 2000”, and “Copyright © 1995-2002”.

The final Office Action cites the reference as a whole, without regard to particular portions. It is apparent that the Examiner initially considered pages dated 2002 or 2003 in making the rejection. The Examiner has not limited his consideration to the content of the prior art *at the time the invention was made*, and has made his determination based upon the content of the art after the filing date of the present application. Use of such art is clearly an impermissible application of hindsight.

**ISSUE 2:**

**Are claims 22-23 unpatentable under 35 U.S.C. §103 as being obvious over a combination of Brown, Pinnisi & Michaels, PC (www.lightlink.com/bbm, Screen Print 1/18/1999) (“BPM”), in view of InventNet (Internet Archive WayBack Machine, www.inventnet.com, Screen Print 12/3/1998 – 2/9/1999) (“InventNet”), further in view of U.S. Patent No. 5,819,092 (“Ferguson”) and U.S. Patent No. 6,298,327 (“Hunter”)?**

In the present Office Action, it appears that dependent claims 22 and 23 stand additionally rejected under 35 U.S.C. § 103(a) as unpatentable over Ferguson and Hunter in combination with BPM and Inventnet. The rejection, insofar as it might be applied to the claims, is respectfully traversed.

The foregoing discussion is incorporated herein by reference.

Ferguson concerns an online service development tool with fee setting capabilities. It is addressed to creating a sophisticated commercial online service with the ability to define fee structures for accessing parts of the online system and/or ordering other goods or services that usually requires specialized programming (e.g., Col. 3, lines 56-61). In the first Office Action, the Examiner admitted that Ferguson has nothing to do with intellectual property. Ferguson does not teach or suggest, interalia, specifics of the online services to be delivered thereby.

Hunter discloses a computer-implemented expert support system for authoring invention disclosures and evaluating patentability/marketability of an invention. Hunter does not discuss the actual filing of the application, nor does Hunter discuss anything concerning fees associated with the filing. Indeed, any discussion of filing or fees in Hunter would be premature, since Hunter is directed to the problem of enabling “inventors to adequately disclose (communicate) the characteristics of their inventions.” (Col. 2, lines 43-45.)



Ferguson is directed to an online service development tool with a fee setter subtool. Hunter is directed to an expert system for authoring an invention disclosure. Consequently, Ferguson and/or Hunter operate in a fundamentally different way than the claimed invention. Specifically, neither Ferguson nor Hunter teach or even suggest, let alone disclose, anything concerning intellectual property services in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions, as claimed.

Moreover, the Examiner completely failed to provide any suggestion or motivation to combine the references with BPM and Inventnet. In view of the complete omission of a motivation to combine the references, there can be no prima facie case of obviousness. In re Dembiczak, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999).

Assuming arguendo, without admission, a motivation to combine the four references, the proposed modification would appear to change the principle of operation of either Hunter or Ferguson, or both. Ferguson does not appear to be appropriate to use with an expert system, as taught by Hunter. Further, Hunter does not appear to be appropriate for use as a third party content provider, as taught by Ferguson. Hence, the proposed combination would appear to require a substantial re-design of Ferguson, as well as some basic changes to the principles upon which Ferguson operates in order to accommodate an expert system. Moreover, the proposed combination fails to make obvious the invention as claimed.

Thus, for all of the reasons discussed above, claims 22 and 23 is not and would not have been obvious over BPM and Inventnet further in combination with Ferguson and Hunter.

### CONCLUSION

For the reasons advanced above, Appellant respectfully contends that each claim is patentable. Therefore reversal of all rejections is courteously solicited.

Respectfully Submitted,



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**APPENDIX**

1. (Previously presented) A computer implemented method for transacting an intellectual property service in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions, the method comprising:

providing a user with information representative of one or more intellectual property services and one or more fees associated therewith wherein the fees include one or more of:

official fees, and

service fees; and

in response to selection by a user of one or more of the intellectual property services, initiating performance of the selected one or more intellectual property services, and substantially coincident with performance thereof, transacting the associated one or more fees.

2. (Previously presented) The method of claim 1, wherein the intellectual property services include one or more of paying an annuity or maintenance fee, making an intellectual property filing on behalf of the user, and preparing and/or filing target jurisdiction- and associate- specific documents for directing and/or effecting the filing and/or payment thereof.

3. (Previously presented) The method of claim 1, wherein the fee transacting includes one or more of authorizing a debit of a deposit account, supplying an invoice, and processing the fee via a payment system.

4. (Previously presented) The method of claim 1, further comprising:

presenting a user with one or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions, wherein the fees associated with a particular one or ones of the intellectual property services are further particularized by target jurisdiction and/or said one or more respective associates.

5. (Previously presented) The method of claim 1, further comprising: automatically initiating the providing of information representative of one or more intellectual property services in response to a docket event for a particular intellectual property matter corresponding thereto.

6. (Previously presented) The method of claim 1, further comprising: retrieving information characterizing an intellectual property application corresponding to one or more intellectual property services from a data store; and calculating the associated one or more fees based on at least a portion of the intellectual property application information.

7. (Previously presented) The method of claim 1, further comprising supplying information encoding the selected one or more intellectual property services and the associated one or more fees for use in an accounting system.

8. (Previously presented) A computer implemented method for transacting intellectual property annuity, maintenance or renewal fee payments, the method comprising: providing, responsive to docket data, information representative of one or more intellectual property matters and one or more fee payments associated therewith, wherein the fees include one or more of:

annuity,

maintenance or

renewal fee payment; and

in response to selection by a user of one or more of the intellectual property matters and associated one or more fee payments, initiating performance of the selected one or more fee payments, and substantially coincident with initiating thereof, initiating a payment transaction corresponding to the selected one or more fee payments between the user and an intellectual property annuity, maintenance or renewal fee payment service.

9. (Previously presented) The method of claim 8, wherein the providing of information representative of one or more intellectual property matters and associated one or more fee payments, and the initiating performance of the selected fee payments are performed by the intellectual property annuity, maintenance or renewal fee payment service.

10. (Previously presented) The method of claim 8, wherein at least the providing of information representative of one or more intellectual property matters and associated one or more fee payments is performed by an intermediary separate from the intellectual property annuity, maintenance or renewal fee payment service.

11. (Previously presented) A method of operating an information service to facilitate fee transactions in connection with the filing of documents and/or payment of fees relating to intellectual property services in one or more target jurisdictions, the method comprising:

registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of fees for one or more intellectual property services performed by the associate therein; and

distributing information representative of one or more of the target jurisdiction, and at least a portion of one or more associates registered therefore and corresponding fees, to a user for use in transacting at least one of the intellectual property services using a respective one or ones of the associates.

12. (Previously presented) The method of claim 11,

wherein the distributing is responsive to selection by the user of one or more of the target jurisdictions and, for each selected target jurisdiction, a respective one or ones of the associates.

13. (Previously presented) The method of claim 11,

wherein the distributing includes supplying, on a periodic basis, to the user, of the computer readable encoding of fees.

14. (Previously presented) The method of claim 11,

wherein the distributing is encoded by a transmittal in at least one computer readable medium selected from the set of a disk, CD-ROM, tape or other magnetic, optical, or electronic storage medium and a network, wireline, wireless or other communications medium.

15. (Previously presented) An information system for transacting fees associated

with intellectual property services in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions, via a network including an originating node and plural target nodes, the target nodes

corresponding to associates licensed or otherwise authorized to perform intellectual property services in one or more target jurisdictions, comprising: an intellectual property service portal coupled by the network to the originating node and one or more of the target nodes, the intellectual property service portal responsive to a selection at the originating node of at least one intellectual property service, supplying the originating node with information representative of one or more fees corresponding to the selected at least one intellectual property service, the intellectual property service portal further responsive to initiation, from the originating node, of the selected at least one intellectual property service, transacting the one or more fees substantially coincident with the initiation thereof.

16. (Previously presented) The information system of claim 15, wherein for a particular selected target jurisdiction and associate combination, the one or more fees include: one or more official fees for an intellectual property filing in the particular selected target jurisdiction; and one or more service fees of the selected associate for performing the selected at least one intellectual property service.

17. (Original) The information system of claim 15, wherein the originating node includes a computer of a managing attorney or intellectual property owner; and wherein the target nodes include computers of respective associates configured to electronically receive at least partial instructions concerning an intellectual

property filing from the managing attorney or intellectual property owner via the intellectual property service portal.

18. (Previously presented) The information system of claim 15, wherein the originating node includes a web browser; wherein the intellectual property service portal includes a web server; and wherein the selection of at least one intellectual property service, the supplying of the information representative of one or more fees, and the transacting of the one or more fees are achieved, at least in part, using internet protocol traffic between the web browser and the web server.

19. (Previously presented) The information system of claim 15, wherein the intellectual property filing portal is further responsive to registration by the associates of information representative of one or more fees corresponding to the associate; wherein the supplied information representative of one or more fees include those registered by the selected associates.

20. (Original) The information system of claim 15, wherein the network includes one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications network segment, and a virtual private network.

21. (Previously presented) A computer program product encoded in a computer readable medium for translating an intellectual property service in connection with the filing of



means for transacting fees substantially coincident with the performance of the selected  
one or more intellectual property services.



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